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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,998	01/17/2002	Nicholas J. Elsey	41698-1036	9128
7590	05/19/2005		EXAMINER	
Alex L. Yip Kaye Scholer LLP 425 Park Avenue New York, NY 10022			CHOULES, JACK M	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/051,998	Applicant(s) ELSEY ET AL.	
	Examiner Jack M. Choules	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 29-50 and 75-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 51-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-28, and 51-74 are presented for examination. Claims 29-50 and 75-92 have been cancelled by applicant's amendment dated 5 February 2005.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 15, 51, and 62 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7-10, 51, and 55-57 are rejected under 35 U.S.C. 102(b) as being anticipated by IBM Technical Disclosure Bulletin [hereinafter IBM] "Method for Data Mining the Statistics of an Internet Yellow Pages Web Service".

5. As to claims 1 and 51, IBM teaches a system comprising: "a database" (page 1, lines 10-22); an interface for receiving communication calls..." (page 1, lines 10-13); "one or more

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devices...” (page 1, lines 10-22); and “a processor for deriving statistical information” (page 2, lines 20-28 and page 3 lines 2-19).

6. As to claims 7, IBM teaches, “accessing the database” (page 3, lines 1-22).

7. As to claims 8, 10, 55, and 57, IBM teaches, “data concerns events” (page 3, lines 1-22).

8. As to claims 9 and 56, IBM teaches, “search categories” (page 3, lines 1-22).

9. Claims 15-17, 19-21, 23-28, 62-64, 66-68, 70-74 and are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson Patent No US 6,016,336 A.

10. As to claims 15 and 62, Hanson teaches a system comprising: “a mechanism for assisting user...” (column 2, lines 40-58); “one or more devices for generating...” (column 4, lines 34-61); “a processor for deriving information...” (column 3, lines 30-41, and column 4, lines 55-66); and “a server for providing information...” (column 4, lines 1-27).

11. As to claims 16-17 and 63-64, Hanson further shows and “an internet” (column 2, lines 59-67 and column 3, lines 1-4).

12. As to claims 19 and 66, Hanson teaches a system including “receiving from the user communication calls requesting assistance” (column 3, lines 42-67).

13. As to claims 20, 21, 67, and 68, Hanson teaches “wireless telephones” (column 3, lines 10-13).

14. As to claim 23, Hanson details “switching facilities” (figure 3 index 30 and 40).

15. As to claims 24-28 and 70-74, Hanson describes “data concerns events” (column 3, lines 42-67, and column 4 lines 1-27) the data concerns the events of searching for entities and selecting extensions to connect the call to.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 14 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM as applied to claims 1 and 51 above.

19. As to claims 14 and 61, IBM does not detail "travel" however, movies are well known in the art and it would be obvious for a Yellow Pages Web Service to be able to find a locations offering travel just as it finds restaurants.

20. Claims 2-6, and 52-54 are rejected under 35 U.S.C. 103(a) as being anticipated by IBM as applied to claims 1 and 51 above, and further in view of Boyle et al. Patent No. US 6,138,158.

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21. As to claims 2, 3, 52, and 53, IBM does not detail “wireless” describing only Internet services Boyle et al. describes a system in which “wireless telephones” are used to connect to Internet services (figure 1, note 112, 104, 106, 116, column 4, lines 58-67 and column 5, lines 1-23).

22. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the concepts of Boyle with IBM because doing so would allow a great amount of the information on the internet including the Yellow Pages Web Service of IBM to be available anywhere and at any time using a device as simple and compact as a mobile phone (Boyle column 1, lines 12-67)

23. As to claims 4 and 54, Boyle does not specifically include “a personal information manager (PIM)” However he does detail a computer, a mobile phone and a personal digital assistant (PDA) it would also be obvious to use a PIM (figure 1 and column 1, lines 26-49).

24. As to claims 5 and 6, Boyle teaches “switching facilities” (column 5, lines 37-58).

25. Claims 11-13 and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM as applied to claims 1, 8, and 10 or 51, 55, and 57 above, and further in view of Golding et al. Patent No. US 6,640,218 B1.

26. As to claims 11 and 58, IBM does not detail “selected as a function of the number of searches...” although IBM does specify counting number of times selected (page 3, lines 8-19) Golding describes a system including “selected as a function of the number of searches...” (column 7, lines 50-64, column 12, lines 62-67 and column 13, lines 1-16).

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27. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Golding and Marwell because Golding provides a ranking based on the popularity of an item based on recent interest as shown by searches run on the data base system improving the versatility of the DB system.

28. As to claims 12 and 59, IBM details "restaurants" (column 18, 61-67 and column 19, lines 1-3).

29. As to claims 13 and 60, IBM does not detail "movies" however, movies are well known in the art and it would be obvious for a Yellow Pages Web Service to be able to find a the location showing the movies.

30. Claims 18, 22, 65, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson as applied to claims 15, 20, 62, and 67.

31. As to claims 18 and 65 Hanson does not specify "a uniform resource locator" (URL) however he does list the possibility of using the Internet (column 3, lines 1-4) and one of skill in the art would realize that when using the internet it is at least obvious to use an URL as it is a standard addressing system for the internet.

32. As to claims 22, and 69, Hanson does not describes including "a personal information manager (PIM)" However he does detail a computer and a mobile phone it would also be obvious to use a mobile computer such as an PIM (column 3, lines 10-13).

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Downs et al. 5,754,960 Dispatch controller with tracking of last N calls.

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

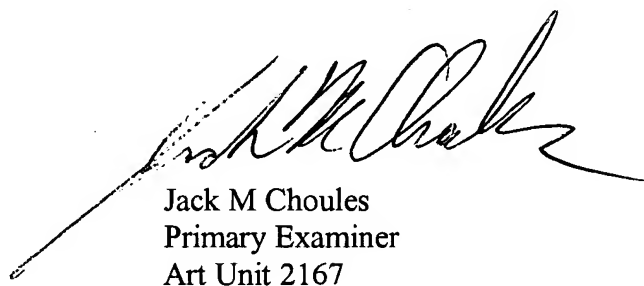
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
Primary Examiner
Art Unit 2167

16 May 2005